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EXAMINER
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SCHIFFMAN, BENJAMIN A

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1791

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ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

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***Response to Arguments***

1. Applicant's arguments filed 11 January 2010 have been fully considered but they are not persuasive.
2. Applicants' first argument, the intermediate product, is not persuasive because the proposed amendment has not been entered, and the claims under final rejection could be the intermediate method steps of Plamthottam.
3. Applicants' next arguments, specifically the amount of solvent in the final composition, is not persuasive for the following reasons. First, in response to applicant's argument that the references, specifically Plamthottam, fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the amount of solvent, the liquid final composition, nor the type of solvent) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). As previously discussed in the Office Action dated 13 October 2009, in response to applicant's argument that Tynan and Plamthottam are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, they are both concerned with the addition of solvent to a polymer in an extrusion apparatus, Tynan further is concerned with the addition of the solvent at multiple inlets which has the improvement of

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eliminating the formation of agglomerates with a slow heating process (see TYNAN column 2 line 63-68) in an intimately mixed cold slurry. Additionally, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

/BENJAMIN SCHIFFMAN/

Examiner, Art Unit 1791

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